

REMARKS

I. General Remarks

Claims 1-12 are all the claims pending in the present application.

Claims 1, 7, and 12 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Shobu, U.S. Patent No. 5,692,130 ("Shobu"). Claims 2, 3, 8, and 9 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Shobu, in view of Yoshida, U.S. Patent No. 5,594,867 ("Yoshida"). Claims 4, 5, 10, and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Shobu, in view of Yoshida and Gregory, U.S. Patent No. 5,909,673 ("Gregory"). Claim 6 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Shobu, in view of Corrigan, U.S. Patent No. 5,966,636 ("Corrigan"). Applicants respectfully traverse these rejections as discussed below.

II. Claims 1, 7, and 12

Claims 1 and 7. Regarding the Examiner's §102(b) rejection of Claim 1, Applicants submit that Shobu fails to disclose or suggest a server, as claimed.

Shobu is generally directed to communication between a calling terminal and a called terminal, and data transmission there between. (Shobu, abstract). As commonly understood, a server is a central computer on a network which processes the requests of a plurality of clients.¹

¹ See, *Merriam-Webster Online Dictionary* at <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=server>, last accessed May 26, 2004 (a computer in a network that is used to provide services (as access to files or shared peripherals or the routing of e-mail) to other ... (footnote continued)

Shobu fails to disclose or suggest a server, as claimed. There is no mention in the disclosure of Shobu of any server, and neither the calling terminal, nor the called terminal, as described, function as a server.

Applicants also submit that Shobu fails to disclose or suggest a monitoring means, as claimed. As noted by the Examiner, Shobu describes determining whether or not both B-channels are in use. (Shobu, col. 5, lns. 58-67). However, this determination does not disclose or suggest monitoring, over a period of time, a state of a free B-channel line, as claimed. In contrast, Shobu merely describes a single determination of the state of the B-channels.

Further, with respect to the Examiner's arguments on page 2 of the current Office Action, Applicants remind the Examiner that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."² Therefore, regarding the Examiner's arguments that descriptions in the references are "functionally equivalent" or to limitations which "would be obvious," Applicants remind the Examiner that arguments relating to obviousness are not proper in a rejection under 35 U.S.C. § 102(b). Further, if the Examiner is arguing that certain claim limitations are inherent in the cited reference, the Examiner has failed to meet his burden. Evidence of inherency in a reference

computers in the network). *See also, The American Heritage Dictionary of the English Language: Fourth Edition* (2000) at <http://www.bartleby.com/61/65/S0286500.html>, last accessed May 26, 2004 (A computer that processes requests for HTML and other documents that are components of webpages).

² *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

“must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”³

“Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”⁴ Even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art disclosure.⁵

Therefore, for at least the above-presented reasons, Applicants submit that Shobu fails to anticipate Claim 1. Applicants also submit that Claim 7 parallels Claim 1 and therefore is patentable for at least the same reasons as presented above. Applicants thus respectfully request that the Examiner’s §102(b) rejection of Claims 1 and 7 be reconsidered and withdrawn.

Claim 12. Regarding the Examiner’s §102(b) rejection of Claim 12, Applicants submit that Claim 12 is patentable for at least the same reasons as presented above with respect to Claim 1, and for the following additional reasons.

³ *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (*emphasis added*).

⁴ *Id.* (citing *In re Oelrich*, 666 F.2d 578, 581 (fed. Cir. 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939))) (*emphasis in original*); see also *Scaltech Inc. v. Retec/Tetra L.L.C.*, 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

⁵ See *Finnigan Corp. v. I.T.C.*, 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was ... (footnote continued)

Shobu fails to disclose or suggest announcing a data transmission time to authorize a user to determine allowance or non-allowance of a transmission, as claimed.

The Examiner refers to Shobu, col. 3, lns. 61-67 to teach this limitation. This portion of Shobu merely describes a call terminal receiving a SETUP message and responding with a CONN message, recognizing that the communication is to proceed in the two-channel mode. There is no disclosure or teaching in Shobu of any announcement to a user or of any user determination of allowance or non-allowance of a transmission, as claimed.

Therefore, for at least the above-presented reasons, Applicants submit that Claim 12 is not anticipated by Shobu and respectfully request that the Examiner's §102(b) rejection of Claim 12 be reconsidered and withdrawn.

III. Claims 2, 3, 8, and 9

With respect to the Examiner's §103(a) rejection of Claims 2, 3, 8, and 9 over Shobu and Yoshida, Applicants submit that Yoshida fails to remedy the above-noted deficiencies of Shobu, and therefore that Claims 2, 3, 8, and 9 are patentable at least by virtue of their dependence on Claims 1 and 7. Applicants submit that these claims are further patentable for the following reasons.

Regarding Claims 3 and 9, the combination of Shobu and Yoshida fails to teach or suggest notifying a server of transmission allowance after a first predetermined amount of time

insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference).

has passed with all B-channels being free or notifying a server of a transmission non-allowance if a second predetermined period of time has passed in which all B-channels are not free, as claimed. The Examiner refers to Shobu to teach these limitations. (Office Action, p. 7).

However, contrary to the assertion of the Examiner, there is no mention of any predetermined period of time in Shobu.

Therefore, for at least the above-presented reasons, Applicants submit that Claims 2, 3, 8, and 9 are patentable over the combination of Shobu and Yoshida and respectfully request that the Examiner's §103(a) rejection of these claims be reconsidered and withdrawn.

IV. Claims 4, 5, 10, and 11

With respect to the §103(a) rejection of Claims 4, 5, 10, and 11 over Shobu, Yoshida, and Gregory, Applicants submit that Gregory fails to remedy the above-discussed deficiencies of Shobu and Yoshida, and therefore, that Claims 4, 5, 10, and 11 are patentable at least by virtue of their dependence on Claims 1, 3, 7, and 9. Applicants thus respectfully request that the Examiner's §103(a) rejection of these claims be reconsidered and withdrawn.

V. Claim 6

With respect to the §103(a) rejection of Claim 6 over Shobu and Corrigan, Applicants note that the limitations of Claim 6 parallel those of Claim 12 and Corrigan fails to remedy the above-noted deficiencies of Shobu. Therefore, Applicants submit that Claim 6 is patentable over Shobu and Corrigan for at least the same reasons as discussed above with respect to Claim 12 and respectfully request that the §103(a) rejection of Claim 6 be reconsidered and withdrawn.

AMENDMENT UNDER 37 C.F.R. § 1.116

U.S. Application No. 09/656,714

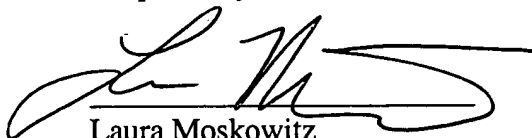
Q60692

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Laura Moskowitz
Registration No. 55,470

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: July 27, 2004